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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/235,242	01/22/99	FRIEDRICH	W 48746

EXAMINER

HM12/0216

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ART UNIT	PAPER NUMBER
1613	17

DATE MAILED: 02/16/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on January 27, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~or thirty days,~~ whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2-6 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 2-6 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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★ U.S. GPO: 1996-404-496/40517

DETAILED ACTION

Claims 2-6 are pending in the application.

Response to Amendment

1. The proposed amendment to claim 5 was not made because the word "used" does not appear in claim 5.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-5 are indefinite because the claims depend from a canceled claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green {U.S. Pat. 4,617,154} in view of Sullivan, III et al. {U.S. Pat. 4,231,956} and O'Lenick, Jr. et al. {U.S. Pat. 5,196,589}.

Applicants claim a process of making a β-alkoxynitrile by reacting an α,β-unsaturated nitrile with an alcohol in the presence of a diazabicycloalkene catalyst. Green teaches a process of making a β-alkoxynitrile and a β-alkylthionitrile by reacting an α,β-unsaturated nitrile with an alcohol in the presence of a diazabicycloalkene catalyst (see columns 1 and 2). Further, Sullivan, III et al. teach additional diazabicycloalkene catalysts useful in the preparation of a β-

alkylthionitrile (column 5, lines 13-25) and O'Lenick, Jr. et al. teach the hydrogenation process instantly claimed (column 4, lines 48-53).

The claimed process is no more than a selective combination of prior art teachings done in a manner obvious to one of ordinary skill in the art since each step of the process appears to be relatively complete in itself and there is no indication of an interaction between steps of such a type that would lead one of ordinary skill in the art to doubt that a substitution of alternative steps known to the art could be made. *In re Mostovych*, 144 USPQ 38 (1964). One skilled in the art would have been motivated to utilize the process of Green, especially in view of the teachings of Sullivan, III et al. and O'Lenick, Jr. et al., with the expectation of obtaining β-alkoxynitrile. Therefore, the claimed process would have been suggested to one skilled in the art.

Response to Arguments

6. Applicants' arguments filed June 29, 1999 have been fully considered. Applicants argue that: (1) Green and Sullivan, III et al. do not teach the instant claimed subsequent catalytic hydrogenation process; (2) a person of ordinary skill would have either removed the basic catalyst used in the first step or neutralized the same before proceeding with the subsequent hydrogenation process; and (3) the product yield is not lost utilizing the instant claimed process; and (4) comparative example 5 shows a lower product yield when a different basic catalyst is used in the process.

All of Applicants' arguments have been considered but have not been found persuasive because Applicants have argued each reference separately. The test for combining references is not what individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the

art. *In re McLaughlin*, 170 USPQ 209 (1971). Further, it would have been obvious to one skilled in the art to perform the hydrogenation process subsequent to the first step in one pot to avoid loss of product yield.

The comparative examples in the instant specification have been considered but the showing was not performed using the closest prior art. None of the comparative examples utilize the diazabicycloalkene catalyst which are used in the instant claimed process and taught in the above cited prior art references of Green and Sullivan, III et al. Additionally, the showing is not commensurate in scope with the instant claims. *In re Greenfield*, 197 U.S.P.Q. 227 (1978) and *In re Lindner*, 173 U.S.P.Q. 356 (1972). For all the reasons given above, the instant claimed process is still found to have been obvious to one skilled in the art.

Conclusion

7. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.

Laura L. Stockton
Patent Examiner
Art Unit 1613, Group 1610
Technology Center 1

July 9, 1999